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In re Application of
Pernice et al. :
Application No. 09/462616 : DECISION ON
PCT No.: PCT/DE98/01922 :
Int. Filing Date: 10 July 1998 : PAPERS UNDER
Priority Date: 10 July 1997 :
For: Method and Device for the : 37 CFR 1.42 AND
 Mutual Authentication of :
Components in a Network Using the : 37 CFR 1.44
Challenge- Response Method :
:

This is a decision on the "Communication in Response to Notice of Missing Requirements Under 35 U.S.C. 371..." filed on 03 April 2000, which is being treated under 37 CFR 1.42 and 1.44.

BACKGROUND

This international application was filed on 10 July 1998, and claimed and earliest priority date of 10 July 1997. A Demand electing the United States was filed on 09 February 1999, which was prior to the elapse of 19 months from the priority date. The International Bureau transmitted a copy of the published international application to the United States Patent and Trademark Office on 21 January 1999. Accordingly, the 30 month time period for paying the basic national fee in the United States expired as of midnight on 10 January 2000.

On 10 January 2000, applicants filed a Transmittal Letter for entry into the national stage in the United States. The Transmittal Letter was accompanied by, *inter alia*, the required basic national fee, but was not accompanied by an executed oath or declaration of the inventors.

On 21 March 2000, a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) was transmitted to applicants, requiring the submission of an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(e).

Applicants filed the instant papers on 03 April 2000.

DISCUSSION

Acceptance of Declaration Under 37 CFR 1.42

The declaration filed on 03 April 2000 has been reviewed and found to satisfy the requirements of 37 CFR 1.42.

Proof of Authority Under 37 CFR 1.44

Petitioner has not furnished satisfactory proof under 37 CFR 1.44 of the authority of the legal representative making the declaration. The evidence currently of record consists of the statement on the declaration that Edith Pernice is signing as the "legal representative" of the deceased inventor. This is inadequate because it does not clearly establish that Edith Pernice is the only heir of inventor Frieder Pernice or, alternatively, that she has been or is expected to be appointed as the legal representative (executor, administrator, etc.) of inventor Frieder Pernice.

Proof of Edith Pernice's authority as legal representative is required, in the form of a certificate of the clerk of a competent court or the register of wills that her appointment is still in force and effect. Such certificate must be signed by an officer and authenticated by the seal of the court by which it was issued. If the certificate is not in the English language, an English translation is also required. In the case of foreign executors or administrators, a consular officer of the United States or a notary public from a member country to the Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents must authenticate the signature of the foreign officer attesting to the papers submitted as proof of authority. If documents are authenticated by a notary public in a member country, an apostille must be used. *See MPEP §§ 409.01(b) and 602.04.*

Alternatively, if Edith Pernice has not been officially appointed as a legal representative but is instead signing as Mr. Pernice's sole heir, MPEP 409.01(a) explains that

Application may be made by the heirs of the inventor, as such, if there is no will or the will did not appoint an executor and if accompanied by a certificate from the court that they are all the heirs and that the estate was under the sum required by state law for the appointment of an administrator.

If the court papers are in a language other than English, an English translation of such papers is required. The translation need not be sworn or affirmed.

If a court certificate is not available, then a legal memorandum prepared and signed by an attorney at law familiar with the law of the jurisdiction involved may be submitted to demonstrate that the persons signing the declaration on behalf of the deceased inventor are all the heirs of the deceased inventor and are authorized to act on behalf of the deceased inventor. A copy (in the English language) of any statute or any court decision relied upon should be made of record.

In either event, proof of Edith Pernice's authority in compliance with 37 CFR 1.44 **MUST** be filed prior to the grant of any patent maturing from this application.

CONCLUSION

The above application and papers have been reviewed and have been found in compliance with 37 CFR 1.42.

The papers filed under 37 CFR 1.42 are **ACCEPTED**.

It is the responsibility of the patent examiner of the application to ensure that proof of authority of the legal representative(s) has been submitted, and to determine whether the proof of authority is sufficient. If, after reviewing the submitted proof of authority, the patent examiner ultimately determines that the authority to execute the application does not lie with the person(s) who executed the oath or declaration of the inventor on behalf of the deceased inventor or that the proof of such authority is insufficient, the application **MUST** be forwarded to the PCT Legal Office for consideration.

It is noted that applicants paid the basic national fee in the amount of \$970.00 under 37 CFR 1.492(a)(3), but were entitled to pay a basic national fee of \$840.00 under 37 CFR 1.492(a)(5) for filing with an EPO search report. Applicants are entitled to a refund of the excess payment in the amount of \$130.00.

The application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for preparation and mailing of a Notification of Acceptance (Form PCT/DO/EO/903) indicating a 35 U.S.C. 371(c) date and 102(e) date of 03 April 2000.



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